

REMARKS/ARGUMENTS

Reconsideration of this Application and entry of this Amendment after Final are respectfully requested. The proposed amendment places the claims in better form for appeal. The present response also replies to the Office Action dated February 24, 2010. Claims 1, 2, 4-7, 9, and 10-35 are pending in the present application. Claims 11-32 were previously withdrawn. Claims 1, 6, and 33 have been amended, claims 29 and 31 cancelled, and claims 36 and 37 added herein. In the Office Action, the Examiner rejected claims 1, 2, 4-7, 9, 10, and 33-35 on various grounds. In view of the amendments and following remarks, favorable consideration and allowance of the application is respectfully requested.

Double Patenting

The Examiner noted the provisional rejection of claims 1, 2, 4-7, 9, 10, and 33-35 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending application 10/827,817. Because the copending claims of application 10/827,817 may change during prosecution, the Applicant will consider filing a terminal disclaimer when the present application is otherwise in condition for allowance.

35 U.S.C. §102 Rejections

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102 rejection, the references cited by the Examiner must show each and every limitation of the claims in complete detail. The Applicant respectfully asserts that the cited references fail to do so.

A. Claims 1, 2, 4-7, 9, 10, and 33-35 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,356,433 to Rowland, *et al.* (the *Rowland* patent).

The Applicant respectfully asserts that the *Rowland* patent fails to disclose, teach, or suggest:

a stent delivery system including a coating disposed on the silane layer, the coating being a non-biologically active polymer, as recited in claim 1;

a coated stent including a coating disposed on the silane layer, the coating being a non-biologically active polymer, as recited in claim 6; or

a coated stent including a polymer coating disposed on the amino silane layer, the polymer coating being a non-biologically active polymer including a therapeutic agent, as recited in claim 33.

At most, the *Rowland* patent discloses covalently linking an organosilane having amine reactive sites with the surface of the metallic member, and covalently linking a biologically active agent to the organosilane coating. *See* Abstract.

Claims 2, 4, 5, and 34; and claims 7, 9, 10, and 35 depend directly from independent claims 1 and 6, respectively. Therefore, the dependent claims include all the elements and limitations of their respective independent claims. The Applicant respectfully submits that dependent claims 2, 4, 5, 7, 9, 10, 34, and 35 are allowable over the *Rowland* patent for at least the same reasons as set forth above with respect to their respective independent claims.

Withdrawal of the rejection of claims 1, 2, 4-7, 9, 10, and 33-35 under 35 U.S.C. §102(b) as being anticipated by the *Rowland* patent is respectfully requested.

35 U.S.C. §103 Rejections

Obviousness is a question of law, based on the factual inquiries of 1) determining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re*

Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See* MPEP 2143.03. The Applicant respectfully asserts that the cited references fail to teach or suggest all the claim limitations.

B. Claims 34 and 35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the *Rowland* patent in view of U.S. Patent No. 4,539,061 to Sagiv (the *Sagiv* patent)

The Applicant respectfully asserts that the *Rowland* patent and the *Sagiv* patent, alone or in combination, fail to disclose, teach or suggest each and every element of the Applicant's invention as claimed, as required to maintain a rejection under 35 U.S.C. §103(a). As discussed in Section A above, the Applicant respectfully asserts that the *Rowland* patent fails to disclose:

a stent delivery system including a coating disposed on the silane layer, the coating being a non-biologically active polymer, as recited in claim 1;

a coated stent including a coating disposed on the silane layer, the coating being a non-biologically active polymer, as recited in claim 6; or

a coated stent including a polymer coating disposed on the amino silane layer, the polymer coating being a non-biologically active polymer including a therapeutic agent, as recited in claim 33.

The *Sagiv* patent also fails to disclose these limitations.

Claims 34 and 35 depend directly from independent claims 1 and 6, respectively, and so include all the elements and limitations of their respective independent claims. The Applicant therefore respectfully submits that dependent claims 34 and 35 are allowable over the *Rowland* patent and the *Sagiv* patent, for at least the same reasons as set forth above for their respective independent claims.

In addition, the *Sagiv* patent fails to disclose a thickness of the silane layer being 8-10 monolayers as claimed. At most, the *Sagiv* patent discloses a multilayer of up to a maximum of four monolayers. *See* column 10, line 63; column 11, line 49. Although the *Sagiv* patent speculates that films of any desired number of layers and thickness are possible, the results of the *Sagiv* patent are limited to four monolayers. Thus, the 8-10 monolayers of the Applicant's invention is a surprising and unexpected result in view of the four monolayers of the *Sagiv* patent.

Withdrawal of the rejection of claims 34 and 35 under 35 U.S.C. §103(a) as being unpatentable over the *Rowland* patent and the *Sagiv* patent is respectfully requested.

New Claims

Claims 36 and 37 have been added herein to more particularly point out and distinctly claim the Applicant's invention. Claims 36 and 37 are allowable over the cited references for at least the reasons discussed above for their respective independent claims 1 and 6. No new matter has been added with the inclusion of claims 36 and 37, which are supported in the specification at least on page 6.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-0221.

Respectfully submitted,

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